

TRANSMITTAL OF APPEAL BRIEF (Large Entity)Docket No.
826In Re Application Of: **WEIDNER, W., ET AL**

Application No.	Filing Date	Examiner	Customer No.	Group Art Unit	Confirmation No.
09/367,569	12/21/1999	TORRES, M.	278	2617	4514

Invention: **RADIO APPARATUS...**COMMISSIONER FOR PATENTS:

Transmitted herewith is the Appeal Brief in this application, with respect to the Notice of Appeal filed on:

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*Signature*Dated: **09/09/2008**

MICHAEL J. STRIKER
ATTORNEY FOR THE APPLICANT
REG. NO.: 27233

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UNITED STATES PATENT AND TRADEMARK OFFICE

Examiner: Torres, M.

Art Unit: 2683

In re:

Applicant: WEIDNER, W., et al

Serial No.: 09/367,569

Filed: December 21, 1999

BRIEF ON APPEAL

August 20, 2008

Commissioner for Patents
P O Box 1450
Alexandria, VA 22313-1450

Sir:

This is an appeal from the final rejection of Claims 22 and 23 by the
primary Examiner.

REAL PARTY IN INTEREST

The real party in interest in this application is IPCom GmbH & Co. KG, Stuttgart, Germany.

RELATED APPEALS AND INTERFERENCES

There are no pending appeals, interferences or judicial proceedings known to appellant, the appellant's legal representative, or assignee, which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

STATUS OF CLAIMS

The present application contains Claims 22 and 23. These claims were rejected by the Examiner. With the present appeal, appellant appeals from the rejection of Claims 22 and 23.

STATUS OF AMENDMENTS

The Final Office Action was issued in this application on May 14, 2008. After the Final Office Action, no amendments were filed in the United States Patent and Trademark Office.

SUMMARY OF CLAIMED SUBJECT MATTER

The present invention relates to a radio apparatus embodied in radio-telephone.

The radio apparatus which is identified with reference numeral 1 has a display device 5, a first control element 11, and a second control element 12. Each of the control elements 11 and 12 are provided for selecting and/or activating functions of the radio apparatus 1 which are displayed on the display device 5.

The first 11 and second 12 control elements are disposed neighboring the display device 5, so that a local association exists between the first 11 and second 12 control elements and displaying of functions of the radio apparatus 1 of the display device 5.

A first operating state is provided in which an information about the first operating state on the display device 5 is associated with the first control element, and the first control element 11 has no function and merely the information about the first operating state is assigned. A function for activating of a second operating state on the display device 5 is associated with a second control element 12. The second operating state is associated with the first

operating state. In the second operating state, an information about the second operating state of the display device 5 is associated with second control element 12. The second control element 12 has no function and merely the information about the second operating state is assigned. A function for activation of the first operating state on the display device 5 is associated with the first control element 11.

This is essentially described in the specification on page 3, lines 10-33, pages 4-9, and page 10, lines 1-30 and illustrated in Figures 1-10 of the drawings. These features are defined in Claim 23.

The radio apparatus 1 also has a third control element 13 and a fourth control element 14 for selecting and/or activating functions of the radio apparatus. In the first and second operating states, the third 13 and fourth 14 control elements are associated with respective functions of the radio apparatus which remain unchanged upon a change between the first and second operating states. This is defined in dependent Claim 22 and disclosed in the same part of the specification and the drawings.

GROUND OF REJECTIONS TO BE REVIEWED ON APPEAL

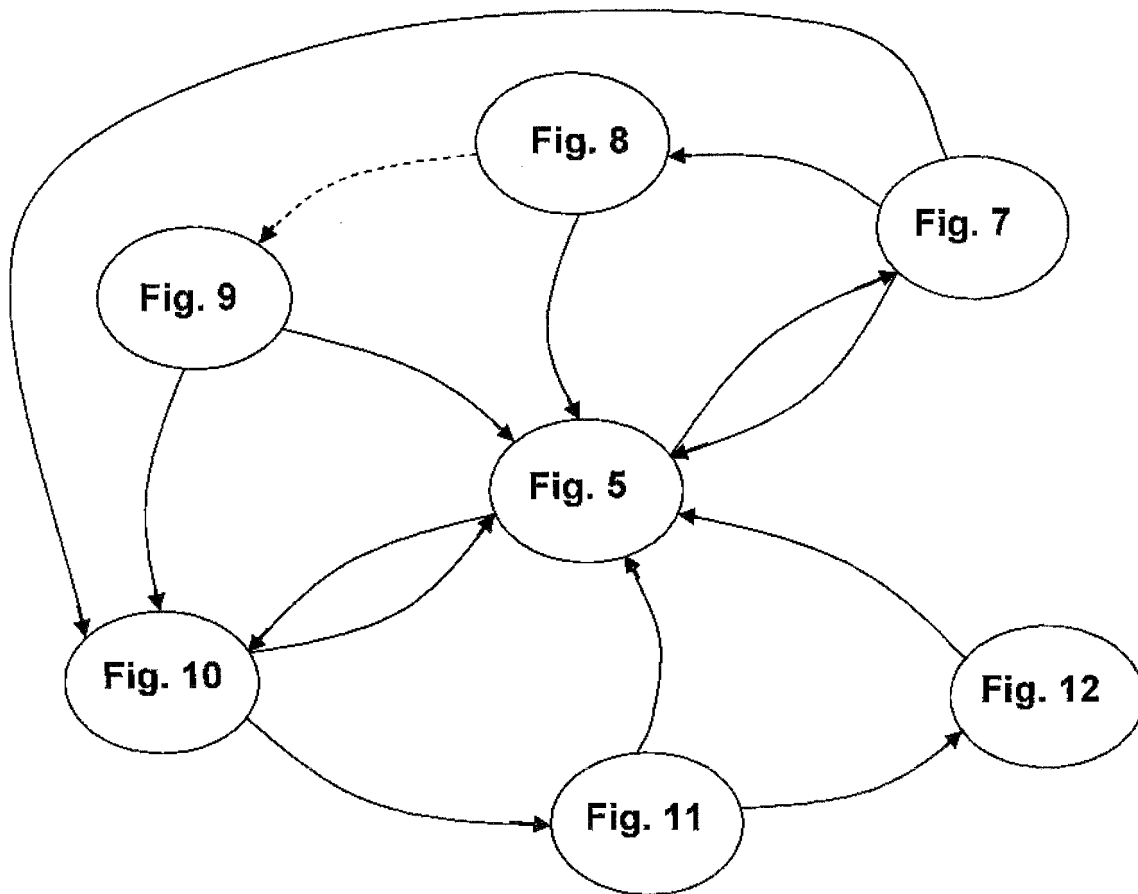
The Examiner rejected Claims 23 and 22 under 35 USC 103(a) as being unpatentable over the U.S. patent to Tsoi in view of the U.S. patent to Baals. Thus, the only ground to be reviewed on appeal is the above-mentioned Examiner's rejection of Claims 23 and 22 over the combination of the above mentioned references.

ARGUMENT

Related to the Examiner's rejection of Claims 23 and 22 under 35 USC 103(a) over the U.S. patent to Tsoi in view of the U.S. patent to Baals.

The U.S. patent to Tsoi discloses a mobile telephone user interface including fixed and dynamic function keys and method of using same. In the patent to Tsoi, either all or certain ones of the soft keys are associated with a control function displayed on the auxiliary display. When the soft keys have no associated function, the auxiliary display is blank in the region adjacent the soft key.

While the transitions between states are not clearly described in Tsoi, it would appear that the following transitions are possible through the pressing of the indicated soft keys:



As can be seen, only two of the transitions are "reversible", those between the states of Fig. 5 and Fig. 7 and the states of Fig. 5 and Fig. 10. In each of the states shown in Figs. 5, 7 and 10, in the screen associated with the soft keys, when a key has no associated function, the display immediately adjacent the key is blank.

The patent to Baals deals with an arrangement for entering information into a directory on a telephone terminal. Baals, on the other hand has a single display which has a top section in which general information is displayed and a bottom section in which information relating to soft keys is displayed. As with Tsoi, when there are soft keys with no associated function, as in Fig. 2 or Fig. 4, the lower part of the display immediately adjacent these non-operative soft keys is blank. In Fig. 6, none of the soft keys are operative and both the top and bottom parts of the display are used to display the message "ENTRY Klein HAS BEEN ADDED TO YOUR DIRECTORY". It is to be noted that there is a difference in case in the lower part between when the text is associated with a soft key and when general information is displayed. Also, when general information is displayed, none of the soft keys are active. The message shown in Fig. 6 is one which concludes the process of storing an entry in the phone book and is essentially a confirmation message, with no return to an earlier state.

In the radio apparatus defined in claim 23, two control elements are recited which are usable to toggle between first and second operating states. In the first state, the second control element activates the second state and in the second state, the first control element activates the first state. In the first state, information about the first state is associated with the first control

element and in the second state, information about the second state is associated with the second control element.

Considering Fig. 5 of Tsoi to correspond to the first operating state, button 82 activates the second state shown in Fig. 7. In Fig. 7, however, button 82 is used to select the call state, i.e. a transition to the state shown in Fig. 8. Similarly, in the state of Fig. 5, button 84 activates the state shown in Fig. 10, in which button 84 controls the transition to the state of Fig. 11. Accordingly, there is no teaching of an arrangement in which pressing a button causes a transition to a different operating state in which that button has no function - in each case the button is associated with a function for transitioning to a further operating state.

The Examiner's statement that the fact that Tsoi did not specifically disclose that the first and second control elements are assigned to merely show the information about the first or second operating states while Baals disclosed the first and second control elements having no functions and merely the information about the first and second operating state are assigned would lead one of ordinary skill in the art as an obvious modification at the time of the invention to the present invention, for displaying additional information of the operating state for the simple purpose of informing the user, cannot be considered as justified and would not lead to the present invention. Tsoi

specifically teaches that the first or second control elements have a function, that of transitioning to a third operating state. The references are not combinable at all because they teach different, mutually contradictory concepts. Baals is designed to display information about a state in the areas associated with the control elements only when none of the available control elements has an associated function. When a function is associated with one or more control elements, only information related to that function is displayed. Otherwise, the screen area is left blank. Therefore, a person of ordinary skill in the art would not combine the references even for these reasons.

It is to be understood that the references did not disclose the new features of the present invention as defined in Claim 23 and did not provide any hint or suggestion for such features. Therefore, any combination of the references would not lead to the present invention as defined Claim 23. In order to arrive at the present invention from a combination of the references, the references have to be fundamentally modified by including into them the above-specified new features of the present invention which were first proposed by the applicant. However, it is known that in order to arrive at a claimed invention, by modifying the references the cited art must itself contain a suggestion for such a modification. This principle also been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision in *re Randol and Redford* (165 USPQ 586) that

Prior patents are references only for what they clearly disclose or suggest, it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

It is therefore believed to be clear that Claim 23 should be considered as patentably distinguishing the present invention from the above analyzed prior art, the Examiner's grounds for the rejection should be considered as not tenable and should be withdrawn, and Claim 23 should be allowed.

As for Claim 22 this claim depends on Claim 23, it shares its allowable features and it should be allowed as well.

With the present Brief on Appeal appellants have also submitted a Simultaneous Amendment to correct the dependency of Claim 22 as suggested by the Examiner.

As for the Examiner's questions raised in paragraphs 2-6 of the Office Action, wherein the buttons are mentioned in the applicant's arguments, it is confirmed that they are represented by corresponding control elements.

Reconsideration of the present application, reversal of the Examiner's rejection, and allowance of the present application are most respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to be 'MJ Striker', written over the printed name.

Michael J. Striker
Attorney for Applicant
Reg. No. 27233

CLAIMS APPENDIX

23. A radio apparatus embodied-in a radio-telephone, comprising a display device; a first control element and a second control element each for selecting and/or activating functions of the radio apparatus which are displayed on said display device; said first and second control elements being disposed neighboring said display device so that a local association exists between said first and second control elements and displaying of functions of the radio apparatus on said display device, wherein a first operating state is provided in which an information about said first operating state on said display device is associated with said first control element, said first control element having no function and merely the information about said first operating state is assigned and in which a function for activation of a second operating state on said display device is associated with said second control element, wherein said second operating state is associated with said first operating state, and wherein in said second operating state an information about said second operating state on said display device is associated with said second control element, said second control element having no function and merely the information about said second operating state is assigned and in which a function for activation of said first operating state on said display device is associated with said first control element.

22. A radio apparatus in accordance with claim 22, wherein said radio apparatus comprises a third and fourth control elements for selecting and/or activating functions of said radio apparatus and wherein in said first and second operating states said third and fourth control elements are associated with respective functions of the radio apparatus which remain unchanged upon a change between said first and second operating states.

EVIDENCE APPENDIX

None.

RELATED PROCEEDINGS APPENDIX

None.